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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202732
Party	Defendant Ecolab USA Inc.
Correspondence Address	DEAN KARAU FREDRIKSON & BYRON PA 200 S 6TH ST STE 4000 MINNEAPOLIS, MN 55402 1425 UNITED STATES ip@fredlaw.com, lfriedemann@fredlaw.com, lmyers@fredlaw.com, dkarau@fredlaw.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Laura L. Myers
Filer's e-mail	lmyers@fredlaw.com
Signature	/Laura L. Myers/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EcoWater Systems LLC,

Opposition No. 91202732

Opposer,

v.

Ecolab USA Inc.

Applicant.

**ECOLAB USA INC.'S RULE 12(B)(6) MOTION AND
MEMORANDUM OF LAW IN SUPPORT THEREOF**

MOTION

Ecolab USA Inc. (“Ecolab”) hereby moves the Board to dismiss Count III of EcoWater Systems LLC’s (“EcoWater”) Amended Notice of Opposition. Count III is based on Ecolab’s alleged lack of use of its mark in particular markets. There is no requirement, however, that an applicant must use its mark on the identified goods in certain channels of trade. An applicant is only required to use its mark in commerce on or in connection with the goods listed in the application. It is undisputed that Ecolab uses its house mark on or in connection with the goods listed in Application Serial No. 85/094,582 (the “582 Application”). As such, EcoWater has failed to state a claim upon which relief can be granted under Rule 12(b)(6) and the Board should dismiss Count III.

Ecolab also requests that, pursuant to Trademark Rule 2.127(d), 37 C.F.R. § 2.127(d), the Board suspend this matter, pending determination of this motion, as of the date of the submission of this motion. After the Board decides Ecolab’s motion to dismiss, Ecolab hereby requests that the discovery, testimony and briefing periods be reset.

MEMORANDUM OF LAW

I. ARGUMENT

A. Rule 12(b)(6) Standard.

The purpose of a Rule 12(b)(6) motion is to allow for elimination of “actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 1160, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993).

To withstand a motion to dismiss for failure to state a claim, a plaintiff needs to allege facts that would, if proved, establish that it has (1) standing to maintain the proceedings, and (2) a valid ground for opposing the mark. *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536 (TTAB 2007). When evaluating a Rule 12(b)(6) motion to dismiss, the plaintiff's well-pleaded allegations are accepted as true, and the complaint is construed in the light most favorable to plaintiff. *Advanced Cardiovascular Systems*, 988 F.2d at 1160, 26 USPQ2d at 1041.

In *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009) and *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007), the Supreme Court clarified the standard applied to motions to dismiss. To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to “state a claim to relief that is plausible on its face.” *Iqbal*, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 570). A claim has facial plausibility only when the plaintiff pleads factual content that allows the fact finder to draw a reasonable inference in the plaintiff's favor. *Id.* A formulaic recitation of the elements of a cause of action will not do. *Papasan v. Allain*, 478 U.S. 265, 286 (1986) (courts “are not bound to accept as true a legal conclusion couched as a factual allegation”).

B. Count III of EcoWater's Amended Notice of Opposition Fails to State a Claim Upon Which Relief Can be Granted.

Count III of EcoWater's Amended Notice of Opposition alleges Ecolab lacks bona fide use in commerce of the ECOLAB mark on certain goods in the identification of goods in the '582 Application in the domestic or home markets prior to the filing of a use-based application for registration under § 1(a) of the Lanham Act. However, EcoWater misstates the use requirements for registration of a mark with the U.S. Patent and Trademark Office ("USPTO") under the Lanham Act. In an application based on use in commerce under § 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), the applicant must only use the mark in commerce on or in connection with all the goods and services listed in the application as of the application filing date. *See* 37 C.F.R. § 2.34(a)(1)(i).

The goods listed in the '582 Application are as follows:

Washing machine water treatment device installed in the rinse modules of the tunnel washer to clean and reduce water consumption and the volume of discharged wastewater by re-circulating wastewater; dispensing units for air fresheners and room deodorants; swimming pool and spa chlorinating units; water treatment equipment, namely, dispensing units for delivering water treatment chemicals to treat scale and corrosion in boilers and cooling tower steam and water systems; electrolytic water generators for electrically decomposing tap water to generate electrolytic water and for removing chlorine odor from tap water; flashlights; portable electric fans; air filtering installations for use in operating clean rooms; chemically activated light sticks; incandescent light sticks; LED luminaires; light bulbs; water filtration and purification units; ultraviolet lamps not for medical purposes; bioreactors for use in the treatment of wastewater; water filtering units for commercial, institutional or industrial use; water filtering apparatus; water purification tanks; water filters.

EcoWater is attacking the following goods in the '582 Application: water filtration and purification units, water filtering apparatus, water purification tanks, and water filters. It is undisputed that Ecolab uses its ECOLAB mark on or in connection with these goods in commerce. In Count III, however, EcoWater is demanding that Ecolab show use of its mark on these goods in specific channels of trade – the domestic or home markets. Such proof is not

required for registration.

Rather, the Lanham Act only requires a written application to specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. 15 U.S.C. §§ 1051(a)(2) and 1051(b)(2); 37 C.F.R. § 2.32(a)(6). Under the Trademark Manual of Examining Procedures (“TMEP”), to “specify” means to name in an explicit manner, and under TMEP § 1402-01(a), with few exceptions, an identification of goods and services will be considered acceptable if it:

- describes the goods and/or services so that an English speaker could understand what the goods and/or services are, even if the grammar or phrasing is not optimal;
- meets the standards (not necessarily the language) set forth in the USPTO’s Identification of Goods and Services Manual (“USPTO ID Manual”);
- is not a class heading; and
- is in the correct class, i.e., there is no language in the identification that makes classification difficult or ambiguous; each class lists goods or services that are clearly in a single class.

Ecolab submits that the identification of goods for the ‘582 Application meets the above criteria.

In fact, Ecolab’s written descriptions come right out of the USPTO ID Manual. This manual comprises a listing of acceptable identifications of goods and services compiled by the Office of the Administrator for Trademark Identifications, Classification and Practice. The USPTO ID Manual contains identifications of goods and services and their classifications that are acceptable in the USPTO without further inquiry by an examining attorney.

Thus, under the Lanham Act and the TMEP, Ecolab is only required to show use of the mark in connection with the goods recited in its application, namely water filtration and purification units, water filtering apparatus, water purification tanks, and water filters. It is undisputed that Ecolab complied with this requirement. Ecolab is not required to show use of its ECOLAB mark in specific channels of trade, and thus need not show use of its mark on the

identified goods in the domestic or home markets as requested by EcoWater, or any other markets or channels of trade for that matter.

Because Ecolab is not required to show use of its mark in particular channels of trade, EcoWater's claim that Ecolab lacks bona fide use in the home or domestic markets is not a proper basis to oppose or otherwise restrict the '582 Application. Accordingly, Count III fails to state a claim upon which relief can be granted, and the Board should dismiss it with prejudice.

II. CONCLUSION

For all of the foregoing reasons, Ecolab requests that the Board grant its motion, finding that Count III of EcoWater's Amended Notice of Opposition fails to state a claim upon which relief can be granted and dismiss Count III with prejudice. Ecolab further requests the Board to stay this proceeding until this motion is decided and reset the remaining deadlines at that time.

Dated: August 6, 2012

/s/ Laura L. Myers

Dean R. Karau

Lora Friedemann

Laura Myers

FREDRIKSON & BYRON, P.A.

200 Sixth Street South, Suite 4000

Minneapolis, MN 55402-1425

(612) 492-7178/7085/7295

ip@fredlaw.com

dkarau@fredlaw.com

lfriedemann@fredlaw.com

lmyers@fredlaw.com

Attorneys for Applicant.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of ECOLAB USA INC.'S RULE 12(B)(6) MOTION AND MEMORANDUM OF LAW IN SUPPORT THEREOF was served by email, pursuant to the parties' agreement, on the attorneys of record for Opposer, Peter T. Holsen, Aaron T. Olejniczak, ANDRUS, SCEALES, STARKE & SAWALL, LLP, 100 East Wisconsin Avenue, Suite 1100, Milwaukee, WI 53202 this 6th day of August, 2012.

/s/ Laura L. Myers

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